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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,865	05/31/2001	Stephen A. Lindia	11252-008	8973

7590 04/21/2005  
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EXAMINER

STIMPAK, JOHNNA

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/870,865	LINDIA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Johnna R Stimpak	3623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. The following is a first office action upon examination of application number 09/870,865. Pending claims 1-20 have been renumbered 1-18 and have been examined on the merits discussed below.

#### ***Claim Objections***

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

**Misnumbered claims 14-20 have been renumbered 12-18.**

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1-3, 6-9** are written in means-plus-function format and for the purpose of this rejection are being treated as though they were method claims. The courts have held that such treatment is acceptable:

"If the functionally-defined disclosed means and their equivalents are so broad that they encompass any and every means for performing the recited functions, the apparatus claim is an attempt to exalt form over substance since the claim is really to the method or series of functions itself. In computer-related inventions, the recited means often perform the functions of "number crunching" (solving mathematical algorithms and making calculations). In such cases the burden must be placed on the applicant to demonstrate that the claim is truly drawn to specific apparatus distinct from other apparatus capable of performing the identical functions."

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If this burden has not been discharged, the apparatus will be treated as if it were drawn to the method or process which encompasses all of the claimed "means." See In re Abele 214 USPQ 682, 688 (CCPA 1982); Ex parte Akamatsu, 22 USPQ 2d 1915, 1920; and Ex parte Alappat, 23 USPQ 2d 1340, 1344.

5. **Claims 1-3, 6, 9, 15 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The use of the word "enabling" is indefinite because it is not clear how the claimed invention is "allowing" or "not allowing" the user to select and input information into the performance review system. An alternative would be to positively recite the steps as suggested, also taking into consideration correction of means plus function language – (in claim 1)...selecting a person whose employment performance... – this is just one example, there are other occurrences in claims 2, 3, 6, 9, 15 and 18. Please make corrections.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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7. Claims 1-18 are rejected under 35 U.S.C. 102(a and e) as being anticipated by Dirksen et al, US 6,853,975.

As per claim 10, Dirksen et al teaches selecting, by a user of the system, a person whose employment performance the user desires to review (column 4, lines 55 – 61 – the users initiate the rating process and select the name of the person they want to rate); inputting employee performance review information into the system by the user (column 5 – the ratings information is input into the system by the user); processing employee performance review information input into the system by the user (column 5, lines 1-25 – the information is processed for report preparation); and storing employee performance review information input into the system by the user (column 5, lines 1-25 – the rating data is stored and submitted to an external company for processing).

As per claim 11, Dirksen et al teaches selecting, by the user, at least one of himself, a superior, a peer, a subordinate and a client to review the user's employment performance (column 1, lines 50-53 - the user selects a group of raters who will complete the ratings process).

As per claim 12, Dirksen et al teaches inputting step comprises inputting of said employee performance review information over a communication network (column 3, lines 25-30 – the evaluation information is transmitted over a network).

As per claim 13, Dirksen et al teaches the communication network is in the Internet (column 3, lines 25-30 – teaches the Internet).

As per claim 14, Dirksen et al teaches the communication network is a business enterprise intranet (column 3, lines 33-37 – the intranet is used for access to the rating system).

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As per claim 15, Dirksen et al does not explicitly teach enabling the user to input said employee performance review information while disconnected from the communication network. However, it is old and well known in the art of communication networks to allow for work to be complete while disconnected from the internet wherein the information can be stored and communicated over a network when there is a network connection present. This feature allows for convenience to the operator wherein he or she can complete the rating while away from the office.

As per claim 16, Dirksen et al teaches means for requiring approval by the users manager of persons selected by the user to review the user's employment performance and persons selected by the user whose employment performance the user desires to review prior to processing and storage of employee performance review information input into the system by the user (column 3, lines 8-25 – the user submits a list of raters for approval by the manager, upon approval/disapproval, the list is stored on an internal file).

As per claim 17, Dirksen et al teaches means for preloading into the storage means a roster of persons with whom the user has had substantial employment related interaction during a relevant review period, wherein the roster of persons includes that may be selected by the user to review the user's employment performance and persons that may be selected by the user whose employment performance the user desires to review (column 3, lines 8-25 – the user submits a list of raters for approval by the manager, upon approval/disapproval, the list is stored on an internal file).

As per claim 18, Dirksen et al teaches enabling the user to enter additional persons into the roster (see figure 1 – there is a rater nomination form that the ratee can update).

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Claims 1-9 are the system for performing the method of claims 10-18 and therefore are rejected in the same manner as claims 10-18 since teaches a computerized system for performing the performance review.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Powers et al, US 6,615,182 – system and method for difining the organizational structure of an enterprise in a performance evaluation system

Lacy et al, US 6,735,570 – system and method for evaluating a selectable group of people against a selectable set of skills

Cloninger, Jr. et al, US 6,865,581 – job analysis system


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R Stimpak whose telephone number is 571-272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS  
4/18/05

  
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